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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,651	03/11/2004	Ernest J. Jensen	926512-100248	6324
23644 7590 05/21/2008 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786			EXAMINER BERTHEAUD, PETER JOHN	
			ART UNIT 3746	PAPER NUMBER
			NOTIFICATION DATE 05/21/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/798,651	<b>Applicant(s)</b> JENSEN ET AL.	
	<b>Examiner</b> PETER J. BERTHEAUD	<b>Art Unit</b> 3746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This Office Action is in response to the Amendments filed 4/8/2008. It is noted that claims 1, 5, and 15 have been amended.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 5-9 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Aytes 3,137,216.

Aytes discloses a cylinder head arrangement comprising a bore within a housing (10, 11, 22, 25, 39) having screw threads along at least a portion of the bore (see inner bore of element 39) and said closure 35 having an internally threaded hole extending into the closure, the system comprising: a retaining cover 40 for obstructing removal of said closure 35 from said bore, the cover 40 being receivable in the bore in a position generally adjacent the closure 35 and having external threads interengageable with said screw threads of the bore (see threads between 39 and 40 in Fig. 1) such that the cover 40 is rotatable relative to the housing in a tightening direction for movement of the cover 40 into the bore toward the closure and rotatable in an opposite, loosening direction for movement of the cover 40 out from the bore away from the closure 35, the cover having a central axis of rotation (see col. 3, lines 15-19); and a locking device 44, 48 configured for being secured to the cover such that the locking device 44, 48 rotates together with

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the cover 40 about said central axis, the locking device 44, 48 comprising a fastener 48 receivable in said hole of the closure 40 and having external threads interengageable with threads of the hole (see Fig. 1); wherein the threads of the cover 40 and the threads of the fastener 48 are spiraled in opposite directions (although not disclosed this can be seen in Fig. 1) such that when the cover 40 rotates in the loosening direction, the fastener 48 becomes tightened in the hole of the closure 35 thereby stopping the rotation; wherein the locking device 44, 48 further comprises a locking member 44 receivable in said central opening of the cover 40, the locking member 44 having a size and shape configured for engagement with an internal wall of the cover 40 for preventing the cover 40 and the locking member 44 from being rotated in different directions at the same time; wherein the locking member 44 has a polygonal shape; wherein the locking member 44 comprises a nut (see Fig. 2); wherein said fastener 48 comprises a threaded bolt extending through the nut; and wherein the bolt (48) is aligned with said central axis of rotation of the cover 40 (see Fig. 1).

In addition, while features of an apparatus may be recited either structurally or functionally, **claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function**, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). **Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim.** In reference to method claim 15, Aytes discloses an apparatus capable of performing a method comprising the steps of:

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installing a retaining cover in said bore adjacent said closure, the cover having screw threads interengageable with screw threads of the bore such that the cover is rotatable relative to the housing in a tightening direction and an opposite, loosening direction, the cover having a central axis of rotation, said step of installing comprising rotating the cover about said axis in said tightening direction; securing a locking device to the cover such that the locking device and cover cannot be rotated in opposite direction about said central axis at the same time; and threading a fastener into a threaded hole in the closure to secure the fastener to the closure, the fastener and hole of the closure having screw threads spiraled in opposite direction to the screw threads of the cover and bore such that when the cover rotates in the loosening direction, the fastener becomes tightened in the hole of the closure thereby stopping the rotation.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aytes 3,137,216.

Aytes discloses a cylinder head arrangement comprising a bore within a housing (10, 11, 22, 25, 39) having screw threads along at least a portion of the bore (see inner bore of element 39) and said closure 35 having an internally threaded hole extending

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into the closure, the system comprising: a retaining cover 40 for obstructing removal of said closure 35 from said bore, the cover 40 being receivable in the bore in a position generally adjacent the closure 35 and having external threads interengageable with said screw threads of the bore (see threads between 39 and 40 in Fig. 1) such that the cover 40 is rotatable relative to the housing in a tightening direction for movement of the cover 40 into the bore toward the closure and rotatable in an opposite, loosening direction for movement of the cover 40 out from the bore away from the closure 35, the cover having a central axis of rotation (see col. 3, lines 15-19); and a locking device 44, 48 configured for being secured to the cover such that the locking device 44, 48 rotates together with the cover 40 about said central axis, the locking device 44, 48 comprising a fastener 48 receivable in said hole of the closure 40 and having external threads interengageable with threads of the hole (see Fig. 1); wherein the threads of the cover 40 and the threads of the fastener 48 are spiraled in opposite directions (although not disclosed this can be seen in Fig. 1) such that when the cover 40 rotates in the loosening direction, the fastener 48 becomes tightened in the hole of the closure 35 thereby stopping the rotation; wherein the cover 40 has right-hand threads and the fastener 48 has left-hand threads (see Fig. 1); wherein said housing 11, 39 is a pump housing and said retaining cover 40 is a pump access port cover. Aytes further discloses a central opening extending through the cover defining an internal wall along the opening (see 40). Aytes also discloses that the closure 35 comprises a plug having a circumferential seal 33 engageable with the bore to close the bore; wherein the bore of the housing has an internal shoulder (see periphery of element 28) and the closure 35 further comprises an

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annular flange 36 which engages the shoulder when the closure is at said installed position; further comprising a stop 28' for preventing rotation of the closure relative to the housing; wherein the flange 36 on the closure 35 has at least one notch 36' therein and when the closure 35 is at said installed position, the stop 28' is received in the notch 36'.

In addition, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (*Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim.

Furthermore, Aytes discloses the claimed invention except for entire bore being unitarily formed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the bore unitary, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (see MPEP 21044.04 V. B - Making Integral).

***Response to Arguments***

6. Applicant's arguments filed 4/8/2008 have been fully considered but they are not persuasive.
7. Applicant's arguments with respect to claims 1-4 and 10-14 have been considered but are moot in view of the new ground(s) of rejection.
8. In response to Applicant's amendment to claim 15: the locking device and the cover in Aytes can indeed be secured in such a way that they would not be able to be rotated in opposite directions at the same time. For example, the cover may be so tight it would remain stationary as the locking device is rotated; thus, they would not be rotating in opposite directions at the same time.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER J. BERTHEAUD whose telephone number is (571)272-3476. The examiner can normally be reached on M-F 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on (571) 272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Devon C Kramer/  
Supervisory Patent Examiner, Art  
Unit 3746

PJB  
/Peter J Bertheaud/  
Examiner, Art Unit 3746

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